

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney's Docket Number: 02037IP

Applicant: Robert Goetze
Serial No.: 10/622,270
Filed: 07/18/03

For: **PROTECTIVE CASUAL FOOTWEAR SUITABLE AS A SLIPPER**

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS

RESPONSE TO OFFICE ACTION DATED JULY 29, 2004

The Applicant, by and through the undersigned attorney, hereby submits this response to the office action mailed July 29, 2004, and would show:

1. The Applicant hereby indicates his desire to ensure that all objections to the claims based upon section 112 have been corrected in the amended claims. In particular the amended claims clarified the extent and location of the protrusion of the enhanced sole of the household slipper to show that it is meant for the protrusion to be all about the circumference of the slipper. The amended claims are also intended to also achieve sufficient limitation of the scope of the claims to satisfy the requirements of section 103 and overcome the objections of the Examiner based upon section 103.
2. Objections to the allowance of claims based upon section 103 essentially allege that the means, methods, and features of the present invention would have been

“obvious” to one of ordinary skill in the art at the time they were made. This objection inherently requires a certain amount of speculation because only objections based upon section 102 can be made based upon the disclosure of previous versions of the same means, methods, and features of the present invention.

3. The case of Graham v John Deere and subsequent decisions have attempted to deal with the issue of resolving the speculative nature of this objection by setting forth a series of objective tests, each of which focus on some aspect of the matter of “obviousness” in order to try and resolve this issue. Among the matters to be considered are whether or not the invention either provides a capability which did not previously exist or whether the invention solves a problem which had been attempted by others but not satisfactorily achieved. Additionally, it may be considered whether a problem which had previously been solved can now be solved or economically in a simpler way, better way, or in any other way which offers some potential advantage to previous solutions.

4. The Applicant respectfully submits that there has been and continues to be a need for an item of footwear which offers the possibility of use both as a simple bedroom or household slipper and also as general footwear for use in and around the house while accomplishing a variety of tasks. For example, such footwear would be very useful in a nursing home or assisted living environments where space and simplicity are vital and the need for protection from falling objects or toe stubs is more

necessary. In other words, an item of footwear which could be immediately put on the feet in the morning upon rising and warrant throughout the day safely and come or toe Blake while performing a variety of household and immediate outdoor tasks and activities, such as simple yard or gardening work, household cleaning tasks, or lounging about either indoors or out doors.

5. Previous slippers were not acceptable for the this because they did not protect the foot from stubs or from falling objects and did not allow protection from articles on the floor or ventilation of the feet suitable for long-term wear. Because the present invention offers a combination of elements which satisfies all of these requirements and because none of the previous disclosures or known products on the market satisfy each of these requirements the Applicant respectfully submits that the claims, as amended to provide one independent claim incorporating all of the limitations necessary to achieve a slipper which satisfies all of these requirements, may be appropriate for allowance and respectfully submits such amendment to the Examiner for further consideration. In particular, the Applicant has included specific levels of protection to the foot to be achieved by the slipper. These include protection from falling household objects as specified within the specification as well as protection from injury resulting from stepping on or stepping into certain hazards which may be encountered in a household environment such as door sills, furniture supports, and broken glass. The level of protection and means of providing such are all matters described within the

specification. The previous efforts in this field did not indicate that the protective levels would be out sufficient strength to guard against these hazards. Accordingly, the invention teaches a capability which was previously not present in footwear intended for use as a household slipper and the addition of this capability clearly as at least minimal utility.

6. The response, including the amended claims, are intended to be fully responsive to the objections of the Examiner and to place the application in a condition for allowance. The Applicant respectfully requests an opportunity to respond to any objections to these comments or any additional requirements or deficiencies which may be noted by the Examiner. The Applicant is not Aware of any drawings corrections which are presently required but desires the opportunity to make any drawings corrections which may be appropriate in light of these amendments or as otherwise noted or required by the Examiner.

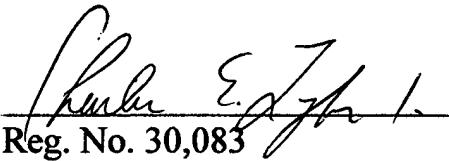
7. This response is submitted within the six-month of the office action since January 29, 2005, and January 30, 2005, were Saturday and Sunday, respectively. The small entity fee for a three month extension (\$490.00) is tendered herewith together with a petition for enlargement of time or waiver of the fees based upon the military service of the undersigned attorney and the fee for this petition (\$200.00).

Wherefore, Applicant respectfully request the Examiner enter and give favorable consideration to and issue a Notice of Allowance with respect to be amended claims

and further waived the three-month extension fee in light of the military service of the
undersigned attorney.

Respectfully Submitted.

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Reg. No. 30,083

1/31/2005
Date